

10/605,888

RECEIVED
CENTRAL FAX CENTERIN THE UNITED STATES PATENT AND TRADEMARK OFFICE **MAY 10 2006**

Bonges, et al.

Serial No.: 10/605,888

Group Art Unit: 2814

Filed: November 4, 2003

Examiner: Ngo, Ngan V.

For: **METHOD OF ASSESSING POTENTIAL FOR CHARGING DAMAGE IN SOI DESIGNS AND STRUCTURES FOR ELIMINATING POTENTIAL FOR DAMAGE**

Commissioner for Patents
Mail Stop Petitions
P.O. Box 1450
Alexandria, VA 22313-1450

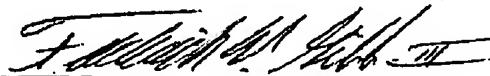
PETITION TO HAVE AMENDMENT UNDER 37 C.F.R. 1.312 ENTERED

Sir:

In response to the Communication dated March 30, 2006, Applicants hereby petition that the Amendment filed on March 17, 2005 be entered, and that claim 3 be reinstated.

Certificate of Transmission by Facsimile

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (Fax No. 571-273-8300) on 5/10/06



Frederick W. Gibb, III

05/11/2006 YPOLITE1 09000101 090456 10605888
01 FC:1462 400.00 DA

10/605,888

REMARKS

In response to a Restriction Requirement dated July 7, 2004, Applicants elected Group 1, (claims 1-24) without traverse. In response to a Species Requirement dated September 2, 2004, Applicant elected Species II, Fig. 3 (which read on claims 1, 4-14, and 16-24). On February 22, 2005, the Notice of Allowability stated that non-elected claim 3 had been cancelled by Examiner's Amendment. On March 17, 2005, Applicants filed an Amendment Under Rule 1.312 to request that claim 3 be reinstated. A Response to the Rule 312 Communication stated that the Amendment filed on March 17, 2005 was disapproved, that claim 1 is not generic to claim 3, the elected Figure 3 does not have the "second conductor" of the shunt device connected to the gate of the SOI transistor, and adding claim 3 will create new matter.

Applicants hereby petition that the Amendment filed on March 17, 2005 be entered, and that claim 3 be reinstated herewith, as provided by 37 CFR 1.141 which states: "more than one species of an invention not to exceed a reasonable number, may be specifically claimed in different claims in one national application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to species in excess of one are written in dependent form or otherwise include all the limitations of the generic claim." As claim 3 is dependent on claim 1, claim 3 necessarily includes all the limitations of claim 1. Therefore, claim 1 is generic to claim 3 (contrary to the conclusion reached in the March 30, 2006 communication). Because 37 C.F.R. 1.141 permits multiple species to be claimed in dependent form from the allowed claims, claim 3 should be reinstated and allowed. Therefore, Applicants respectfully request that claim 3 be reinstated.

Further, section 809 of the MPEP states "upon the allowance of the linking claim(s), the Examiner must notify Applicant that any canceled, non-elected claim(s) which depends from or requires all the limitations of the allowable linking claim may be

10/605,888

reinstated by submitting the claim(s) in an Amendment." Applicants have submitted such an Amendment on March 17, 2006. Thus, claim 3 should be reinstated and allowed.

Section 821.04(a) of the MPEP states "a requirement for restriction should be withdrawn when a generic claim, linking claim, or subcombination claim is allowable and any previously withdrawn claim depends from or otherwise requires all the limitations thereof. Claims that require all the limitations of an allowable claim will be rejoined and fully examined for patentability in accordance with 37 CFR 1.104." Therefore, Applicants petition that the Amendment filed on March 17, 2005 be entered, and that claim 3 be reinstated and allowed.

Please charge the petition fee of \$400.00 and any deficiencies to Attorney's Deposit Account Number 09-0456.

As this error was caused on the part of the Patent Office, please credit the petition fee of \$400.00 and any deficiencies and credit any overpayments to Attorney's Deposit Account Number 09-0456.

Respectfully submitted,

Frederick W. Gibb, III
Reg. No. 37,629

Date: 5-10-06
Gibb I.P. Law Firm, LLC
2568-A Riva Road, Suite 304
Annapolis, Maryland 21401
(410) 573-1545
Customer No. 29154